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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,770	11/16/2000	Adam Coyle		3444

20350 7590 07/05/2007
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EXAMINER

CAMPEN, KELLY SCAGGS

ART UNIT	PAPER NUMBER
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3691

MAIL DATE	DELIVERY MODE
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07/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/713,770

Applicant(s)

COYLE, ADAM

Examiner

Kelly Campen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22, 24-31 and 33-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 24-31, 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Based on the arguments in the Appeal Brief filed 4/2/07, Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. A new action on the merits follows.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 37-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 37 appears to be directed to a method for issuing prepaid negotiable instruments to an account holder but the body of the claim is mainly directed to a transaction terminal for issuing the negotiable instruments. The metes and bounds of the claim are unclear. In addition, there is not a **positively recited method step** of issuing **prepaid negotiable instruments to an account holder**. Lines 10-17 appear to be directed towards providing a server system where a negotiable (not prepaid) instrument is issued.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 22, 24-31, 33-38 rejected under 35 U.S.C. 102(e) as being anticipated by Gatto (US 6149055).

Gatto discloses system for issuing prepaid negotiable instruments to an account holder, comprising: a database for storing, in relation to a prepaid account of the account holder, an account identifier and a balance associated with the prepaid account, wherein the balance represents funds deposited to the prepaid account as advance payment for negotiable instruments (see col. 10, lines 60-65—travelers checks are the negotiable instrument issued--), wherein withdrawals against the prepaid account are made only by issuance of negotiable instruments, and wherein the prepaid account is maintained by a non-banking institution and the prepaid account is thus not an FDIC insured account (see col. 10, lines 60-65 and column 9, lines 35-40); a transaction terminal for issuing negotiable instruments, the terminal including a card reader for reading a card having data thereon representing the account identifier, an input device for entering the amount of the negotiable instrument, and a printer for printing the amount on the negotiable instrument (col. 6-8 and abstract, col. 2, lines 27-37); a server system in communication with the database and the transaction terminal, the server system receiving the

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account identifier in response to the card being read at the transaction terminal, accessing the database to determine the balance within the prepaid account associated with the account identifier, authorizing a negotiable instrument to be issued at the terminal if there is a sufficient balance within the account to cover the amount of the instrument, and debiting the prepaid account by the amount of the issued negotiable instrument (see col. 11, lines 13-20 –account identifier—and col. 13 lines 65 to column 14 line 2); and a communication link connecting the server system for receiving data from a banking institution, the data relating to a sweep account maintained by the banking institution for receiving deposits for the account holder and immediately crediting those deposits to the prepaid account (see col. 8, lines 50-52 –prompt user for other transaction parameter--see abstract, col. 6-8) and the system of electronic funds may be used to issue negotiable instruments (col. 5, lines 40-45, in addition see abstract, see col. 2-5, see figs. 1, 5-6).

Specifically as to claim 24, wherein the deposits received at the sweep account are direct deposits through an automated clearinghouse (ACH) system (see col. 12 lines 45-47 and col. 16 lines 10-20).

Specifically as to claim 25, wherein a personal identification number (PIN) is associated with the card, wherein the card is presented by the account holder at the transaction terminal, and the PIN is entered at the input device of the terminal in order for the account holder to request issuance of a negotiable instrument (see col. 12 , lines 1-10).

Specifically as to claim 26, wherein the account is an anonymous prepaid account, wherein the database stores no identifying personal information concerning the account holder, and wherein the server system authorizes issuance of a negotiable instrument without requiring identifying

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information concerning the account holder other than the account identifier and the PIN (see col. 12, lines 4-7).

Specifically as to claim 27, wherein the account is an anonymous prepaid account, wherein the database stores no identifying personal information concerning the account holder other than the account holder name to appear as payee on the negotiable instrument, and wherein the server system authorizes issuance of a negotiable instrument without requiring identifying information concerning the account holder other than the account identifier and the PIN (see col. 12 lines 4-7 and col 10 lines 60-65).

Specifically as to claim 28, wherein the negotiable instrument is issued in the name of the account holder, and wherein the negotiable instrument is preprinted with a restrictive legend requiring identification for cashing the negotiable instrument (see col. 10, lines 60-65).

Specifically as to claim 29, wherein the negotiable instrument is further preprinted with a restrictive legend setting an upper limit for its face value (see col. 10 lines 60-65).

Specifically as to claim 30, wherein the transaction terminal is an automated teller machine (ATM) (see col. 4 lines 8-10).

Specifically as to claim 31, wherein the transaction terminal is a point of sale (POS) terminal (see col. 10 lines 60-66).

Specifically as to claim 33, wherein the non-banking institution is a Licensed Money Transmitter (LMT), wherein the LMT requires a transaction fee for issuing the negotiable instrument, and wherein the transaction fee is deducted from the account when the negotiable instrument is issued (see col. 10 lines 60-66).

Specifically as to 34, wherein the server system authorizes a negotiable instrument to be issued at

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the terminal if there is a sufficient balance within the account to cover the amount of the transaction fee in addition to the amount of the negotiable instrument (see col.10 lines 60-66 and col. 9 lines 30-50).

Specifically as to claim 35, wherein the printer prints the name of the account holder on the negotiable instrument so that the negotiable instrument is payable to the account holder (col. 10 lines 60-66).

Specifically as to claim 36, wherein the balance associated with the account and stored in the database is limited to a predetermined maximum value (see col. 10, lines 60-66).

Specifically as to claim 38, further comprising printing the name of the account holder on the negotiable instrument as the payee and printing a restrictive legend requiring identification in order to cash the negotiable instrument (see col. 10, lines 60-66).

Response to Arguments

Applicant's arguments with respect to claims 22, 24-31, 33-38 have been considered but are moot in view of the new ground(s) of rejection.

In response to Appellant's argument that claim 37 recites several clear method steps, Examiner wishes to point out that in the 35 USC 112 2nd paragraph rejection, the Examiner was attempting to have the appellant clarify the method and not simply adapt claim 22 into a method claim through the preamble. In addition, the Appellant refers to method steps with regards to describing the server and not to methods of issuing a prepaid negotiable instrument.

In addition, the Appellant has not clearly included a step of issuing a prepaid negotiable instrument as indicated by the preamble. If applicant had simply amended the step of issuing a negotiable instrument to –issuing a prepaid negotiable instrument—the rejection would have been overcome.

In response to appellant's argument against the 35 USC 103 (a) rejection, the argument is moot as for the new grounds of rejection listed above. Appellant argues Gatto does not disclose or suggest all the limitations recited in claim 22. Examiner has clearly shown where in the Gatto reference as indicated above, the limitations may be found. Specifically, appellant's argue that the instant claimed invention of claim 22 permits consumers who are cash-based to make deposits into a banking account and then conduct transaction against a prepaid account maintained by a non-banking institution (see Gatto col. 9, lines 35-40) but this is contradictory. The instant claim is directed in lines 7-8 to a 'non-banking institution' while then referring to the same account as being a 'banking institution, the data being related to a sweep account maintained by the banking institution for receiving deposits for the account holder and immediately crediting those deposits to the prepaid account' in lines 20-22. Appellant appears to contradict the invention. Gatto discloses 'financial institutions' in column 7, line 7 and this term encompasses the terms bank and non-bank institutions. A financial institution, as defined by Baron's Financial Dictionary (page 202), is an institution that collects funds from the public to place in financial assets such as stocks, bonds, money market instruments, bank deposits, or loans.

Appellant further argues that Gatto merely discloses and suggests a conventional ATM system, and does not show an arrangement where deposits are made to a sweep account at a

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banking institution and are then immediately credited to a prepaid account at a non-banking institution where the prepaid account is not an FDIC insured account, and where funds are withdrawn only as negotiable instruments (see Gatto col. 2 lines 28-30 as disclosing the use of EFT systems and col. 2, lines 28030 and column 3 lines 38-44 and col. 8 lines 13-19 col. 10 line s60-65 where Gatto discloses issuing travelers checks as negotiable instruments and reading on the instant claimed invention). In regards to appellant's argument that a sweep account is not taught in Gatto, see col. 8, lines 50-52 'prompt user for other transaction parameter' as Gatto can program the terminal to do a wide range of functions. Examiner is concerned with the use of the term 'sweep account' as the applicant is not using the term in the common and well known in the art form. A sweep account is merely a account that empties funds as the end of the business day while applicant may be his own lexicographer, it must not contradict the accepted meaning . Appellant's claimed invention merely and simply transfers the cash deposited to a prepaid account of the member as is done when an individual is paying for traveler's checks with cash (a prepaid negotiable instrument). In addition, where the funds are in a sweep account has no effect on the invention and is non functional descriptive matter as a if it were a true sweep account as defined in the financial industry, it would be an account providing that a bank invest all the excess available funds at the close of each business day to an interest account (see dictionary.com).

In regards to appellant's argument against the rejection of dependent claims 24-31, 33-36, and 38, the argument is moot as the Examiner has withdrawn the Official notice and issued a new grounds of rejection. The limitations of the dependent claims can be found within the Gatto

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reference as within the scope of the invention or within the scope of the defined system and terms.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Examiner has cited several dictionary sources to define several terms within the instant claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Campen whose telephone number is (571) 272-6740. The examiner can normally be reached on Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kelly S Campen